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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,001	09/24/1999	ADEN DALE HIATT, JR.	HTT-9901	1129

7590

05/08/2002

LAW OFFICE OF DALE B. HALLING
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COLORADO SPRINGS, CO 80903

EXAMINER

CRAVER, CHARLES R

ART UNIT

PAPER NUMBER

2685

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.
09/406,001

Applicant(s)
Hiatt, Jr.

Examiner
Charles Craver

Art Unit
2685



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Apr 11, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

4. ☐ Applicant's reply has overcome the following rejection(s):

5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see attached office action

7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1-11 and 13-20
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☐ Other:

Art Unit: 2685

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 4-11-02 have been fully considered but they are not persuasive.

In regard to the asserted 'legal errors':

the examiner stands behind the Official Notice used in e.g. claim 3, as, when challenged by the applicant to provide references, such references were supplied in earnest. Both references supplied by the examiner show quite clearly the notoriously well known nature of the limitations which were rejected.

Secondly, the examiner is quite aware, having communicated with the applicant's representative numerous times, that the Microsoft publications are not prior art. This is why said publications are not used in the prima facie case that the examiner has set forth under 35 USC 103(a), but is cited as an aid to the applicant in understanding the process of downloading a .pab file in Outlook '97, if he or she so wishes. This is why the examiner cites the references stating "for a more detailed explanation of said process", as merely an aid to the applicant.

Regarding the use of Official Notice or findings of inherent equivalence, the examiner understands that both actions are completely legitimate Patent Office procedure, and that the use of both in an office action is allowed by law. As noted above, in response to the applicant, the

Art Unit: 2685

examiner has provided in the previous office action references which show the notorious nature of the limitations over which Official Notice was taken.

Further, while Outlook stores a new .pab file, the first claim does not specifically teach away from such a system. Rather, in a case where Outlook receives a .pab file and stores it when there is no .pab file present, such a method would account for a stored set of data in a database (i.e. Outlook's allocated memory). While the Microsoft publication which has been thoroughly proven not to be counted on as teaching prior art teaches that one .pab may not be merged with another, there is no teaching in e.g. claim 1 to which such a teaching would apply. That is, there is no teaching in the claims which teaches towards merging of databases. Again, the examiner reiterates that the storing of the .pab file in the second device means that the addresses are stored in an address database.

Conclusion

2. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

Art Unit: 2685

(703) 872-9314 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, sixth floor (receptionist).


3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Craver whose telephone number is (703) 305-3965.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Urban, can be reached on (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

cc

C. Craver
May 1, 2002


EDWARD F. URBAN
SUPERVISORY PATENT EXAMINER
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